

## REMARKS

The claims have been amended as indicated above. The amendments are being made to clarify the invention. The amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

Restriction

Applicant traverses the restriction requirement because the claims are not independent or distinct. The statutory basis for a restriction requirement reads as follows:

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.

35 U.S.C. § 121 (emphasis added). Thus, the PTO may restrict an application only if the claimed invention satisfies both requirements (*i.e.*, both independent and distinct). The Office Action only states that the claimed invention is distinct, but does not address the other requirement that the claims be independent. In the present case, Applicant submits that neither requirement is met.

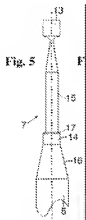
The claims are not “independent” (*i.e.*, not dependent) under 35 U.S.C. § 121. Namely, the claims disclose a relationship between the two or more subjects disclosed, that is, they are connected in design, operation, and effect. MPEP 802.01 give two examples of how claims can be “independent”; namely, (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process. The Office Action has not established either case.

The claims also are not “distinct” under 35 U.S.C. § 121. MPEP 802.01 defines “distinct” as meaning that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art). The present claims do not disclose two or more subjects, but rather disclose a single subject; namely, guide wires structures and associated uses. Thus, the claims are not distinct.

The Applicants provisionally elected to prosecute Group I (claims 1-20).

102 over Rasmussen

The Office Action rejected claims 1-3, 5-8, 12, 13, and 15-20 under 35 U.S.C. § 102(b) as being anticipated by Rasmussen (5,725,534). Applicants traverse this rejection and request reconsideration because this cited portions of the reference do not teach or suggest the combination as currently claimed. Rasmussen discloses an assembly for positioning an embolization coil in the vascular system. The Office Action cites to Fig. 5 of Rasmussen, which shows an enlarged section of the core in the distal end of the wire, comparing the first segment with reference numeral (5), the second segment with reference numeral (13), and the third segment with reference numeral (15). Fig. 5 is reproduced below for convenience:

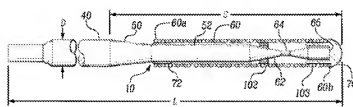


In contrast, independent claim 1 currently recites “a flexible elongate second segment”. Claim 1 further recites, “third segment functions as a hinge and is positioned distally relative the first and second segments.” Also consider independent claim 20 that currently recites, “a flexible elongate second segment.” Claim 20 further recites, “flexible third segment . . . being capable of bending between a first position where the first and second segments are axially aligned and a second position where the first and second segments extend proximally from the third segment and generally parallel one another.” Since these and other features recited in the independent claims 1 and 20 are not taught or suggested in the cited portions of Rasmussen, all the independent claims are novel over Rasmussen and should be in a condition for allowance.

Claims 2-3, 5-8, 12, 13, and 15-19 should also be in a condition for allowance by depending from allowable independent claims. Applicants note, however, that the dependent claims recite further limitations that distinguish over the art of record.

102 over Viera

The Office Action rejected claims 1-4, 6-13, 15, and 18-20 under 35 U.S.C. § 102(b) as being anticipated by Viera (5,807,279). Applicants traverse this rejection and request reconsideration because this cited portions of the reference do not teach or suggest the combination as currently claimed. Viera discloses a guidewire having a radiopaque distal tip. The Office Action compares the first segment with references numerals (40, 52, 62), the second segment with reference numeral (65), and the third segment with reference numeral (64). The cited portions of Viera reference Fig. 2, which is reproduced below for convenience.

Fig-2

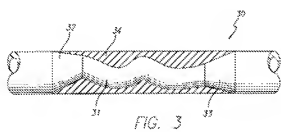
In contrast, independent claim 1 currently recites “a flexible elongate second segment”. Claim 1 further recites, “third segment functions as a hinge and is positioned distally relative the first and second segments.” Also consider independent claim 20 that currently recites, “a flexible elongate second segment.” Claim 20 further recites, “flexible third segment . . . being capable of bending between a first position where the first and second segments are axially aligned and a second position where the first and second segments extend proximally from the third segment and generally parallel one another.” Since these and other features recited in the independent claims 1 and 20 are not taught or suggested in the cited portions of Viera, all the independent claims are novel over Viera and should be in a condition for allowance.

Claims 2-4, 6-13, 15, and 18-19 should also be in a condition for allowance by depending from allowable independent claims. Applicants note, however, that the dependent claims recite further limitations that distinguish over the art of record.

102 over Boyle

The Office Action rejected claims 1-3, 5-8, 12, 13, 15, and 18-20 under 35 U.S.C. § 102(b) as being anticipated by Boyle (6,290,656). Applicants traverse this rejection and request reconsideration because this cited portions of the reference do not teach or suggest the combination as currently claimed. Boyle discloses a guide wire with a damped force vibration

mechanism. The Office Action cites to Fig. 3 and compares the first segment with reference numeral (15), the second segment with reference numeral (15), a the third segment with reference numeral (31). Fig. 3 is reproduced below for convenience.



In contrast, independent claim 1 currently recites, “third segment functions as a hinge and is positioned distally relative the first and second segments.” Also consider independent claim 20 that currently recites, “flexible third segment . . . being capable of bending between a first position where the first and second segments are axially aligned and a second position where the first and second segments extend proximally from the third segment and generally parallel one another.” Since these and other features recited in the independent claims 1 and 20 are not taught or suggested in the cited portions of Boyle, all the independent claims are novel over Boyle and should be in a condition for allowance.

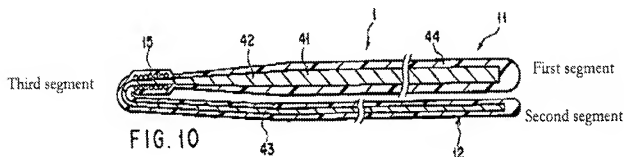
Claims 2-3, 5-8, 12, 13, 15, and 18-19 should also be in a condition for allowance by depending from allowable independent claims. Applicants note, however, that the dependent claims recite further limitations that distinguish over the art of record

#### 103 over Onuki in view of Imran

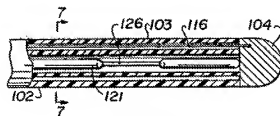
The Office Action rejected claims 1-10, 12-15 and 18-19 under 35 U.S.C. § 103(a) as being obvious over Onuki (2002/0087100) in view of Imran (5,389,073). Applicants traverse the rejections and request reconsideration because a *prima facie* case of obvious has not been established. The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. To establish a *prima facie* case of obviousness, as specified in MPEP § 2143, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicants traverse the obviousness rejections because the cited references do not teach or suggest all the claim limitations (see MPEP § 2143.03). Onuki discloses a medical guide wire having a fixed portion so that the position of the guide wire relative to an endoscope is fixed. The Office Action cites to Fig. 10 and made the following comparison with the first, second, and third segments:



The Office Action acknowledged that Onuki fails to disclose the third segment having a bending moment of inertia less than a bending moment of inertia of the first or second segments. The Office Action relies on Imran to compensate for the shortcoming of Onuki, citing to Fig. 6 of Imran and comparing the first segment with reference numeral (121), a second segment, and a third segment with reference numeral (126). Fig. 6 is reproduced below for convenience.



**FIG. 6**

In contrast, independent claim 1 currently recites the following combination, “third segment functions as a hinge and is positioned distally relative the first and second segments, the third segment having a bending moment of inertia less than a bending moment of inertia of the first segment and less than a bending moment of inertia of the second segment.” Also consider independent claim 20 that currently recites, “flexible third segment . . . being capable of bending between a first position where the first and second segments are axially aligned and a second position where the first and second segments extend proximally from the third segment and

generally parallel one another.” Since these and other features recited in the independent claims 1 and 20 are not taught or suggested in the cited portions of Onuki and Imran, a *prima facie* case of obvious has not been established and the claims should be in a condition for allowance.

Beyond the shortcoming with respect to all claim limitations being taught or suggested, a *prima facie* case of obvious has not been established because there is no suggestion or motivation to modify the combined reference teachings (see MPEP § 2143.01). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Neither Onuki or Imran suggest or motivate the combination as currently recited in the pending claims. Without the requisite teaching, suggestion or motivation, a *prima facie* case of obvious has not been established. In addition, there is no reasonable expectation of success in any such combination (see MPEP § 2143.02), thus further establishing that a *prima facie* case of obvious has not been established.

Claims 2-10, 12-15 and 18-19 should also be in a condition for allowance by depending from allowable independent claim 1. Applicants note, however, that the dependent claims recite further limitations that distinguish over the art of record.

### Conclusion

Based on the foregoing, all of the pending claims are in a condition for allowance. Applicants traverse all rejections and request reconsideration, and Applicants request an early notice of allowability.

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